

nAttorney Docket No. 3477-89PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Egan et al.

Serial No.: 09/674,237

International Application No.: PCT/CA99/00375

International Filing Date: April 27, 1999

Priority Date: April 27, 1998

For: ESE GENES AND PROTEINS

Date: August 21, 2001

#4

BOX PCT

Commissioner for Patents

Washington, DC 20231

**RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE  
AND REQUEST FOR CORRECTION**

Sir:

In reviewing the Notification of a Defective Response (*hereinafter*, "the Notification") mailed August 6, 2001 (copy enclosed), Applicants note errors appearing in the document. The Notification acknowledges Applicants' response of July 20, 2001, but indicates that the Oath or Declaration and Surcharge have not been submitted. However, the Declaration and Surcharge were filed on July 20, 2001, and a copy of the return-receipt postcard is attached herewith for verification.

Applicants contacted Ms. Anita Johnson (who signed the Notification) by telephone to discuss this matter. Ms. Johnson acknowledged that the Declaration and Surcharge were submitted, and stated that she believed that such receipt was indicated on the Notification. She further acknowledged that only the Sequence Listing (which is submitted concurrently herewith) is outstanding.

Applicants believe that the Notification was incorrectly completed and, accordingly, is unclear as to which documents have been submitted and which are outstanding. Specifically, Applicants believe that the boxes indicating incompleteness of Oath or Declaration and Surcharge were checked in error, and that the Notification should have indicated incompleteness of a Sequence Listing.

Applicants spoke with a representative of the PCT Help Desk by telephone regarding this matter, who suggested that a written request for issuance of a corrected Notification be submitted. Accordingly, to create an accurate and complete record, Applicants are requesting that a corrected Notification be issued.

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Applicants further call attention to the second page of the Notification of a Defective Response, which specifically outlines the requirements for submittal of a Sequence Listing. Accordingly, enclosed herewith are the Transmittal Papers, Sequence Listing, and a Petition and Fee for Extension of Time for one month, responsive to the Notification to Comply of May 21, 2001.

Should the Office personnel have any questions regarding this matter, please do not hesitate to contact the undersigned attorney.

Respectfully submitted,

  
Karen A. Magri  
Registration No. 41,965

**Customer Number:**



**20792**

PATENT TRADEMARK OFFICE

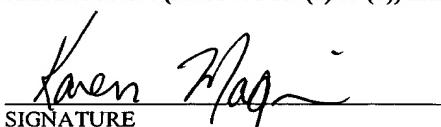
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX PCT; Commissioner for Patents, Washington, DC 20231, on August 21, 2001

  
Traci A. Brown  
Date of Signature: August 21, 2001

209087

FORM PTO-1390 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE (REV 5-93) <b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371</b>		ATTORNEY'S DOCKET NUMBER  <b>3477-89</b>
INTERNATIONAL APPLICATION NO.  <b>PCT/CA99/00375</b>	INTERNATIONAL FILING DATE  <b>27 April 1999</b>	U.S. APPLICATION NO. (if known, see 37 C.F.R. 1.5)  <b>09/674,237</b>
TITLE OF INVENTION  <b>EE GENES AND PROTEINS</b>		
APPLICANT(S) FOR DO/EO/US  <b>Sean E. EGAN; Wei WANG; Ameet SENGAR</b>		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
<p>1. <input type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a filing under 35 U.S.C. 371.</p> <p>2. <input checked="" type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a filing under 35 U.S.C. 371.</p> <p>3. <input type="checkbox"/> This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(l).</p> <p>4. <input type="checkbox"/> A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.</p> <p>5. <input type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2))        a. <input type="checkbox"/> is transmitted herewith (required only if not transmitted by the International Bureau).        b. <input type="checkbox"/> has been transmitted by the International Bureau.        c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US).</p> <p>6. <input type="checkbox"/> A translation of the International Application into English (35 U.S.C. 371(c)(2)).</p> <p>7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))        a. <input type="checkbox"/> are transmitted herewith (required only if not transmitted by the International Bureau).        b. <input type="checkbox"/> have been transmitted by the International Bureau.        c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.        d. <input type="checkbox"/> have not been made and will not be made.</p> <p>8. <input type="checkbox"/> A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).</p> <p>9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).</p> <p>10. <input type="checkbox"/> A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).</p>		
<b>Items 11. to 16. below concern other document(s) or information included:</b>		
<p>11. <input type="checkbox"/> An Information Disclosure Statement under 37 C.F.R. 1.97 and 1.98.</p> <p>12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.</p> <p>13. <input type="checkbox"/> A <b>FIRST</b> preliminary amendment.  <input type="checkbox"/> A <b>SECOND</b> or <b>SUBSEQUENT</b> preliminary amendment.</p> <p>14. <input type="checkbox"/> A substitute specification.</p> <p>15. <input type="checkbox"/> A change of power of attorney and/or address letter.</p> <p>16. <input checked="" type="checkbox"/> Other items or information: Statement in Support of Sequence Listing; Sequence Listing (68 pages hard copy and diskette); Petition and Fee for Extension of Time (1 mo.)</p>		

U.S. APPLICATION NO. (If known, see 37 C.F.R. 1.50) 09/674,237	INTERNATIONAL APPLICATION NO. PCT/CA99/00375	ATTORNEY'S DOCKET NUMBER 3477-89		
17. <input checked="" type="checkbox"/> The following fees are submitted:  <b>Basic National Fee (37 CFR 1.492(a)(1)-(5)):</b> Search Report has been prepared by the EPO or JPO ..... <b>\$860.00</b>  International preliminary examination fee paid to USPTO (37 CFR 1.482) ..... <b>\$690.00</b>  No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445(a)(2)) ..... <b>\$710.00</b>  Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO ..... <b>\$1,000.00</b>  International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(1)-(4) ..... <b>\$96.00</b>		<b>CALCULATIONS</b>		
ENTER APPROPRIATE BASIC FEE AMOUNT = <b>\$860.00</b>		<b>\$</b>		
Surcharge of <b>\$130.00</b> for furnishing the oath or declaration later than [ ] 20 [ ] 30 months from the earliest claimed priority date (37 CFR 1.492(e)).				
Claims	Number Filed	Number Extra	Rate	
Total Claims	58 - 20 =	38	X \$18.00	\$
Independent Claims	26 - 3 =	23	X \$80.00	\$
Multiple dependent claim(s) (if applicable)		+ \$270.00		\$
<b>TOTAL OF ABOVE CALCULATIONS</b> =				\$
Reduction by 1/2 for filing by small entity, if applicable. Verified Small Entity statement must also be filed. (Note 37 CFR 1.9, 1.27, 1.28).				\$
<b>SUBTOTAL</b> =				
Processing fee of <b>\$130.00</b> for furnishing the English translation later than [ ] 20 [ ] 30 months from the earliest claimed priority date (37 CFR 1.492(f)).				\$
<b>TOTAL NATIONAL FEE</b> =				<b>\$65.00</b>
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). <b>\$40.00</b> per property +				<b>\$40.00</b>
<b>TOTAL FEES ENCLOSED</b> =				<b>\$105.00</b>
		Amount to be refunded	\$	
		charged	\$	
<p>a. <input checked="" type="checkbox"/> A check in the amount of <u><b>\$55.00</b></u> to cover the fee for Extension of Time is enclosed.</p> <p>b. <input type="checkbox"/> Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees. A duplicate copy of this sheet is enclosed.</p> <p>c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0220.</p>				
NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.				
SEND ALL CORRESPONDENCE TO:  Karen A. Magri Myers Bigel Sibley & Sajovec Post Office Box 37428 Raleigh, North Carolina 27627				
<div style="border: 1px solid black; padding: 5px;"> <p><b>CERTIFICATE OF MAILING</b></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to BOX PCT, Commissioner for Patents, Washington, DC 20231, on August 21, 2001</p> <p> Traci A. Brown Date of Signature: August 21, 2001</p> </div>				
 <b>SIGNATURE</b>  <u>Karen A. Magri</u>  <b>41,965</b> <b>REGISTRATION NUMBER</b>				